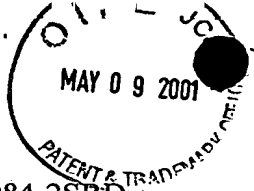


0039-6084-2SRD



#12/Req. for Reconsideration
ME
5/6/01

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF:

Yeh et al.

GROUP: 2162

SERIAL NO. 09/207,954

EXAMINER: Alvarez, R.

RECEIVED
MAY 14 2001
Technology Center 2100

FILED: December 9, 1998

FOR: AN INTEGRATED, INTERACTIVE
TELEPHONE AND COMPUTER
NETWORK COMMUNICATIONS
SYSTEM

COMBINED REQUEST FOR PERSONAL INTERVIEW
AND REQUEST FOR RECONSIDERATION

ASSISTANT COMMISSIONER FOR PATENTS
WASHINGTON, D.C. 20231

SIR:

The following request for a personal interview and request for reconsideration are submitted in response to the Office Action dated November 9, 2000.

REQUEST FOR PERSONAL INTERVIEW

Ownership of the present application has been transferred to a new party. It is, therefore, respectfully requested that a Personal Interview be granted to a representative of the new assignee of the present application. The Examiner is requested to contact the undersigned, Michael R. Casey, at 703-412-6217 to arrange a mutually convenient time for such a personal interview. (The undersigned's office is in Crystal City and can generally make himself available for such a personal interview on short notice.) The attached Associate Power of Attorney provides the undersigned with the authority to conduct an interview in this

application. A Revocation and New Power of Attorney, executed by the assignee, will be filed shortly.

REQUEST FOR RECONSIDERATION

Favorable reconsideration of this application, in light of the following discussion, is respectfully requested. Claims 1-44 are currently pending in this application. No claims have been amended herewith.

In the outstanding Office Action, claims 14-17 and 31-34 were rejected¹ under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,974,398 (hereinafter "the '398 patent") in view of U.S. Patent No. 6,076,068 (hereinafter "the '068 patent"); claims 35-37 were rejected² under 35 U.S.C. § 103(a) as being unpatentable over Mendler, "Competition drives operators towards retail innovation"; Claims 1, 4, 5, 11, 12, 18, 21, 22, 28-30, 38³ and 41 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,933, 778 (hereinafter "the '778 patent") in view of EP 0 732 835⁴ A2 (hereinafter "Civanlar"); and claims 2, 3, 6-8, 10, 19, 20, 23-25, 27, 39 and 40 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the '778 patent in view of Civanlar and further in view of U.S. Patent No. 5,974,398 (hereinafter "the '398 patent").

¹Based on the text of section 5, it appears that the introductory paragraph stating that claims 14 and 31 were rejected was intended to also include dependent claims 15-17 and 32-34. Therefore, the rejection has been treated for both the independent and dependent claims.

²Based on that ground for rejection, and in light of the comments in section 9 of the Office Action, it is believed that the cover sheet of the Office Action is in error when it identifies claims 35-37 as allowable.

³Based on the text of section 7, it appears that the introductory paragraph stating the claims rejected thereunder should have included claim 38. Therefore, the rejection has been treated accordingly.

⁴The reference appears to correspond to U.S. Patent No. 5,995,606 (hereinafter "the '606 patent"), which issued November 30, 1999 .

In response to the rejection of claims 14-17 and 31-34 under 35 U.S.C. § 103(a) as being unpatentable over the '398 patent in view of the '068 patent, that ground for rejection is respectfully traversed. The Office Action admits that the '398 patent "does not specifically teach storing a personal message for a particular subscriber." Office Action, page 2, last line, to page 3, line 1. This admission indicates that the '398 patent does not teach or suggest either of the "assigning" or "delivering" steps as claimed in claim 14. The Office Action, however, seeks to make up the admitted deficiency by arguing that the '068 patent "teaches storing specific messages for specific customers based on their demographics and prior purchasing habits." In actuality, this argument shows that the '068 patent has the same deficiency as the '398 patent. If the '068 patent teaches "storing specific messages for specific customers based on their demographics and prior purchasing habits" and delivers those messages to subscribers, then the '068 patent is simply "delivering to said subscriber a marketing message corresponding to said demographic information." Neither patent, therefore, discloses storing a personal message (which is separately recited from a marketing message). Moreover, since neither patent discloses storing a personal message, then neither patent can disclose "delivering ... a marketing message ... when the subscriber accesses said personal messages." Accordingly, the combination of the '398 and '068 patents does not render obvious the subject matter of claim 14.

The cited motivation is also believed to be untenable. Each application was already providing demographically targeted marketing messages to users, and neither patent indicated that there was a need that was not met by those patents. Nonetheless, the Office Action asserts that one of ordinary skill in the art would have been motivated to make the combination "because such a modification would increase the customer's attention to the advertisement." Office Action, page 3, line 5. The Office Action provides no support for how the combination would have actually increased a customer's attention to the message. The

Office Action also does not cite any references to prove (or even suggest) that, at the time of Applicants' filing, one of ordinary skill in the art recognized a need for customers to pay more attention to advertisements. Consequently, it is respectfully requested that the rejection of claim 14 (and dependent claims 15-17) be withdrawn.

Claim 31 recites an essentially parallel claim to claim 14, but in the reverse (i.e., receiving versus delivering) format. As discussed above, since the combination of the '398 patent and the '068 patent only teaches marketing messages, the combination fails to teach personal messages stored in a storage space such that marketing messages are received when retrieving personal messages. As a result, the rejection of claim 31 (and dependent claims 32-34) should also be withdrawn for the reasons set forth above for the patentability of claim 14.

In response to the rejection of claims 35-37, that ground for rejection is respectfully traversed. The Office Action asserts that "it is well known to place conference calls that deliver marketing messages." Office Action, page 4, line 12 of section 6. It appears that the Office Action is taking Official Notice of this alleged fact since no reference has been cited to support the assertion. It is respectfully requested that the next Office Action provide a reference that supports this assertion. Similarly, the example of a mortgage company using conference calls to provide marketing messages is also unsubstantiated. The Office Action has not shown that any such conference has occurred such that it would constitute prior art against this application. Until such time as a prior art reference has been produced that shows delivering marketing messages during a conference call, it is respectfully submitted that the Office Action has not yet established a prima facie case of obviousness, and this ground for rejection should be withdrawn.

With respect to the asserted motivation for the modification of Mendler, it is respectfully submitted that the Office Action has not established that one of ordinary skill in

the art recognized that a time savings was possible by making the modification. The Court of Appeals for the Federal Circuit has stated that:

"Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings of references can be combined only if there is some suggestion or incentive to do so." Although couched in terms of combining teachings found in the prior art, the same inquiry must be carried out in the context of a purported obvious "modification" of the prior art. The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification.⁵

With respect to claims 36 and 37, those claims are patentable for reasons analogous to the reasons set forth for the patentability of claim 35. That is, by failing to prove that prior art exists as to playing marketing messages during a conference call, the Office Action has failed to establish a prima facie case of obviousness. Therefore, the rejection of claims 36 and 37 should also be withdrawn.

In response to the rejection of claims 1, 4, 5, 11, 12, 18, 21, 22, 28-30, 38 and 41, that ground for rejection is respectfully traversed. The Office Action alleges that

since ... Buhrmann teaches that the systems maintains a subscriber profile database (118) then it would have been obvious to a person of ordinary skill in the art at the time of Applicant's [sic] invention to have included using the subscriber profile database to generate a message associated with a product or service provider of interest to the subscriber.

Page 6, lines 13-16. Once again, the Office Action provides no citation for the alleged motivation to modify the reference in violation of the holding in In re Fritch. Absent the court mandated explanation, it is respectfully submitted that the Office Action has not established a prima facie case of obviousness with respect to claim 1 (and dependent claims 2-13).

⁵ In re Fritch, 23 USPQ2d 1780, 1784-85 (Fed. Cir. 1992) (quoting ACS Hosp. Systems, Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984)).

With respect to claim 18, it is respectfully submitted that claim 18 is patentable for reasons analogous to the reasons set forth for the patentability of claim 1. Specifically, the same motivation for modifying Buhrmann that was missing for claim 1 is missing for claim 18. Accordingly, claim 18 (and dependent claims 19-30) are patentable, and the outstanding ground for rejection should be withdrawn.

With respect to claim 38 (and dependent claims 39-44), those grounds for rejection are respectfully traversed. The Office Action asserts that:

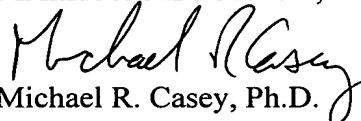
Official Notice is taken that [it] is old and well known to send mail (e-mail) message[s] to remind patients to call the doctor's office to schedule yearly routine check ups. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's [sic] invention to have included receiving via the Buhrmann management system an e-mail reminder telephone call because such a modification would allow the subscriber to open the e-mail at a time that is convenient for him or her.

Office Action, page 7, lines 8-13. That assertion not only does not provide support for the alleged motivation in violation of In re Fritch, it also misses the point. The telephone call is claimed as being made to inform the subscriber of the e-mail message. How does this allow a subscriber to open the e-mail at a time that is convenient for him or her? Without a tenable motivation, claims 38-44 are patentable over the cited references.

Consequently, the pending claims are believed to be patentably distinguishing over the prior art and in condition for allowance. An early and favorable action to that effect is respectfully requested.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.


Michael R. Casey, Ph.D.

Registration No. 40,294

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22850

Docket No. 208456US67

IN RE APPLICATION OF Yeh et al.

SERIAL NO: 09/207,954

FILED: December 9, 1998

FOR: AN INTEGRATED INTERACTIVE TELEPHONE AND COMPUTER...



2161 2761 \$

ASSISTANT COMMISSIONER FOR PATENTS
WASHINGTON, D.C. 20231

SIR:

Transmitted herewith is an amendment in the above-identified application.

- ☐ No additional fee is required
- ☐ Small entity status of this application under 37 C.F.R. §1.9 and §1.27 is claimed.
- ☒ Additional documents filed herewith: Petition for Extension of Time (3 mo.)

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The Fee has been calculated as shown below:

CLAIMS	CLAIMS REMAINING		HIGHEST NUMBER PREVIOUSLY PAID	NO. EXTRA CLAIMS	RATE	CALCULATIONS
TOTAL	44	MINUS	44	0	× \$18 =	\$0.00
INDEPENDENT	7	MINUS	7	0	× \$80 =	\$0.00
		<input type="checkbox"/> MULTIPLE DEPENDENT CLAIMS			+ \$270 =	\$0.00
		TOTAL OF ABOVE CALCULATIONS				\$0.00
		<input type="checkbox"/> Reduction by 50% for filing by Small Entity				\$0.00
		<input type="checkbox"/> Recordation of Assignment			+ \$40 =	\$0.00
		TOTAL				\$0.00

- ☒ A check in the amount of **\$890.00** is attached.
- ☒ Please charge any additional Fees for the papers being filed herewith and for which no check is enclosed herewith, or credit any overpayment to deposit Account No. 15-0030. A duplicate copy of this sheet is enclosed.
- ☒ If these papers are not considered timely filed by the Patent and Trademark Office, then a petition is hereby made under 37 C.F.R. §1.136, and any additional fees required under 37 C.F.R. §1.136 for any necessary extension of time may be charged to Deposit Account No. 15-0030. A duplicate copy of this sheet is enclosed.

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